

Application No. 10/518,886  
Docket No. 2002B096/2  
Amdt. dated August 4, 2006  
Reply to Office Action of June 6, 2006

RECEIVED  
CENTRAL FAX CENTER  
AUG 04 2006

REMARKS

This reply is in response to the Office Action dated June 6, 2006. Claims 1-7, 9-33, and 35-50 are pending in the application and stand rejected. Claims 1, 9, 24, and 48 are amended. Applicant has also canceled claim 8 without prejudice and presented the subject matter of claim 34 in independent form by amending base claims 1 and 24. Entry of the foregoing amendment and reconsideration of the claims is respectfully requested.

Claims 1-7 and 9-50 stand rejected under 35 U.S.C. § 102(a or e), as being anticipated by Tsou et al. (either US 6,875,813 or WO 200157340) hereafter "Tsou."

Applicant respectfully traverses the rejection. The amended claims overcome the rejection because Tsou does not teach, show, or suggest a composition suitable for an air barrier comprising an elastomer, processing oil and plastomer, wherein the plastomer is a copolymer of ethylene derived units and C<sub>3</sub> to C<sub>10</sub>  $\alpha$ -olefin derived units and has a density of less than 0.915 g/cm<sup>3</sup>; and wherein paraffinic, naphthenic and aromatic oils are absent from the composition, as recited in the base claims and those dependent therefrom. The processing oil, FLEXON™ 876, listed in Table 1 of Tsou is a naphthenic oil, see Table 1 note 4 of Tsou. Accordingly, withdrawal of the rejection and allowance of the amended claims is respectfully requested.

Claims 1-7 and 9-50 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of Tsou. For reasons discussed above, Tsou does not teach, show or suggest the claimed invention as amended and therefore, claims 1-50 are not anticipated by or obvious over the claims of Tsou. Accordingly, a rejection on the grounds of nonstatutory obviousness-type double patenting should be withdrawn. Withdrawal of the rejection and allowance of the claims 1-7, 9-33, and 35-50 is respectfully requested.

Claims 1-7, 9-10, and 24-50 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Simonutti et al. cited above in view of Coran (US 4,130,534) hereafter "Coran." Because there is no citation of Simonutti in the Office Action, Applicants believe that these claims stand rejected over Tsou in view of Coran. Furthermore, the Office Action discussed in great detail of Tsou in view of Coran.

The Office Action admits Tsou does not disclose or suggest a processing oil. Yet, the Office Action asserts that because Coran "discloses an elastomeric composition and that extender oil is 'desireable' to improve processability and other properties," it would have been obvious to use extender oil as taught by Coran "to improve properties."

Application No. 10/518,886  
Docket No. 2002B096/2  
Amdt. dated August 4, 2006  
Reply to Office Action of June 6, 2006

Applicants respectfully traverse the rejection on grounds that a combination of the references does not teach, show, or suggest the claimed invention. The motivation suggested in the Office Action is to improve processability by "adding extender oil to an elastoplastic composition." Indeed, green strength improved as demonstrated in Table 3 of Tsou (the higher the green strength the better processability). However, Tsou squarely demonstrated the decreasing trend of the air impermeability (increasing trend of air permeability) as shown in Table 5 of Tsou.

Applicants application demonstrated the exact opposite trend of increasing air impermeability (decreasing trend of air permeability) as shown in Table 6 of the Applicant's application with similar green strength (see Table 5 of the Applicants' application). Indeed, the air permeability decreased from 4.53 to 2.45  $\text{cm}^3\text{-cm/cm}^2\text{-sec-atm} (\times 10^8)$ .

Applicants submit that Tsou and Coran teach squarely away from applicants' claimed invention as amended. Applicants submit that by studying Tsou and Coran, a person of ordinary skill would not be motivated to combine Tsou and Coran to improve air impermeability because it is against simple logic to combine Tsou and Coran for improving air impermeability. The teaching of Tsou and Coran clearly demonstrates the exact opposite trend, i.e., decreasing air impermeability. Furthermore, the results disclosed in the Applicants' application are surprising in view of the teaching of Tsou and Coran. The air impermeability improves with similar green strength (processability).

Applicants also respectfully traverse the rejection on grounds that the Office Action has not established a *prima facie* case of obviousness. To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. See In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Further, the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in the applicants' disclosure. See M.P.E.P. § 2143, citing In re Vacck, 947 F.2d 488 (Fed. Cir. 1991). Still further, the examiner must *particularly* identify any suggestion, teaching or motivation from *within* the references to combine the references (emphasis added). See In Re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999). Here, the Office Action has provided no suggestion, teaching or motivation from *within* the references to combine their teachings. The motivation or teaching found in the cited references logically teaches away from the claimed invention as currently amended.


Applicants respectfully submit that withdrawal of the rejection and allowance of the claims is respectfully requested.

Application No. 10/518,886  
Docket No. 2002B096/2  
Amdt. dated August 4, 2006  
Reply to Office Action of June 6, 2006

Having addressed all issues set out in the office action, Applicant respectfully submits that the pending claims are now in condition for allowance. Applicant invites the Office Action to telephone the undersigned attorney if there are any issues outstanding which have not been addressed to the Office Action's satisfaction. A petition for extension of time for filing this response is attached; however, in the event that petition becomes separated from this Response, the Commissioner is hereby authorized to charge counsel's Deposit Account No. 05-1712, for any fees, including extension of time fees or excess claim fees, required to make this response timely and acceptable to the Office.

Respectfully submitted,

August 4, 2006  
Date

  
Xiaobing Feng  
Attorney for Applicant  
Registration No. 57,231

ExxonMobil Chemical Company  
Law Technology  
P.O. Box 2149  
Baytown, Texas 77522-2149  
Phone: 281-834-0355  
Fax: 281-834-2495